



**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)  
0942.5640006/LEA/R  
LP

In re Application of: Timothy V. Updyke et al.

Application No.: 09/728,378

Filed: November 28, 2000

For: System for pH-Neutral Stable Electrophoresis Gel

The owner\*, Invitrogen Corporation, of one hundred (100) percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory terms defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,922,185 and Patent No. 6,162,338. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patents are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory terms as defined in 35 U.S.C. 154 to 156 and 173 of the prior patents, as presently shortened by any terminal disclaimer, in the event that they later: expire for failure to pay a maintenance fee, are held unenforceable, are found invalid by a court of competent jurisdiction, are statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, have all claims canceled by a reexamination certificate, are reissued, or are in any manner terminated prior to the expiration of their full statutory terms as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

Linda E. Alcorn  
Signature

4/1/03  
Date

Linda E. Alcorn  
Typed or printed name

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this statement. See MPEP § 324.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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## Certificate Under 37 C.F.R. § 3.73(b)

Applicant/Patent Owner: Timothy V. Updyke et al.

Application No./Patent No.: 09/728,378 Filed/Issue Date: November 28, 2000

Entitled: System for pH-Neutral Stable Electrophoresis Gel

Invitrogen Corporation

(Name of Assignee)

, a corporation

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. ☒ the assignee of the entire right, title, and interest, or
2. ☐ an assignee of an undivided part interest

in the patent application/patent identified above by virtue of either:

A. ☐ An Assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached.

OR

B. ☒ A chain of title from the inventor(s) of the patent application/patent identified above to the current assignee as shown below:

1. From: Timothy V. Updyke and Sheldon Englehorn To: Novel Experimental Technology

The document was recorded in the Patent and Trademark Office at  
Reel 9701, Frame 0968.

2. From: Novel Experimental Technology To: Novex

The document was recorded in the Patent and Trademark Office at  
Reel 009942, Frame 0239.

3. From: Novex To: Novex, as a wholly owned subsidiary of Invitrogen Corporation

The document was filed in the Patent and Trademark Office on January 27, 2003.

4. From: Novex, as a wholly owned subsidiary of Invitrogen Corporation To: Invitrogen Corporation

The document was filed in the Patent and Trademark Office on January 28, 2003.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☒ Copies of document number 3 and 4 in the chain of title are attached.

**[NOTE:** A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the PTO. See MPEP 302-302.8]

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

Signature: \_\_\_\_\_

Name: Alan W. Hammond

Title: Chief Intellectual Property Counsel

Date: \_\_\_\_\_

3/18/03

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 4.18.03

APPL. S.N.: \_\_\_\_\_

EXAMINER: \_\_\_\_\_

ART UNIT: 1753

PARALEGAL: BRIAN HARDEN

MAILROOM DATE: 4.1.03

AFTER FINAL: YES \_\_\_ NO \_\_\_

NUMBER OF T.D.(S) FILED: \_\_\_\_\_

INSTRUCTIONS: I have reviewed the submitted T. D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T. D. If you disagree any analysis or have questions at all about the acceptability of the T.D., please see our Special Program Examiner or me.

THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE. WHEN YOUR OFFICE ACTION IS COMPLETED, YOU MUST INITIAL AND DATE & RETURN THIS TO PARALEGAL.

☒ The T. D. is PROPER and has been recorded. (See 14.23)

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24)

☐ The recording fee of \$ \_\_\_\_\_ has not been submitted nor is there any pre authorization in the application to charge to a deposit account. (See 14.25)

☐ Application Examiner has not processed fee for T. D.

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T. D. has not stated his/her interest and the extent of the interest of the business entity represented by the signature in the application/patent. (See 14.26)

☐ The T. D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting Rule 321(c). (See 14.27 and 14.27.1)

☐ T. D. is directed to a particular claim(s), which is not acceptable since the disclaimer must be of a terminal portion of the entire patent to be granted, MPEP 1490. (See 14.26 and 14.26.2)

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28)

☐ is not recognized as an officer of the assignee. (See 14.29.1)

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the frame specified as to where such evidence is recorded in the office. 37CFR 3.73(b). (See 1140 O.G. 72) NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30)

☐ No "STATEMENT" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and behalf the file is in the assignee seeking to take action 37 CFR 3.73(b). (See 1140 O.G. 72)

☐ The T. D. is not signed (See 14.26 and 14.26.3)

☐ Attorney is not of record in the oath/declaration or a separate paper filed appointing a new or associate attorney, nor is there a customer number.

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32)

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.4 or 14.26.6)

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)

☐ Other \_\_\_\_\_